

**REMARKS**

Claims 44, 46-50, 52-57, 59-64, 66-72, 74-79, and 81-92 are pending in this application. Claims 44, 46-50, 52-57, 59-64, 66-72, 74-79, and 81-86 are amended herein. Claims 45, 51, 58, 65, 73, and 80 are cancelled herein without prejudice or disclaimer. Claims 87-92 are added herein. Support for the amendments to the claims may be found in the claims as originally filed and in the specification.

In particular, support for a "creating unit" can be found in the specification at page 19, lines 8-13, page 9, lines 7-10, page 36, lines 10-16. Support for a "number of times" can be found at page 22, lines 11-16. Support for a "homepage" can be found at page 24, lines 11-18. Support for a "recreation notifying unit" can be found at page 24, line 22 to page 25, line 3. Support for a "preparing unit" can be found at page 9, lines 10-14 and at page 20, lines 5-18. Support for new claims 87, 89, and 91 may be found in Figs. 3 and 9, and at page 26, line 5 to page 27, line 7. Support for new claims 88, 90, and 92 may be found in Figs. 14, 20, and 23, and at page 30, line 15 to page 31, line 7, and at page 32, lines 17-21. Reconsideration is requested based on the foregoing amendment and the following remarks.

**Response to Arguments:**

The Applicants appreciate the consideration given to their arguments. The Applicants, however, are disappointed that their arguments were not found to be persuasive. The final Office Action responded to the arguments at the end of each of the paragraphs in section 5 at pages 10 and 11 by asserting that since Jacobs describes transmitting a playlist to a client computer which allows a user to select, download, or display advertisements, Jacobs is similar to the claimed invention. "Similarity" of a reference, however, is not enough to anticipate a claim under 35 U.S.C. § 102(e). 35 U.S.C. § 102(e), rather, provides:

A person shall be entitled to a patent unless -  
(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent.

Thus, even if it were true that Jacobs were *similar* to the claimed invention, the claimed invention would still be patentable over Jacobs since the claimed invention is not *described* in Jacobs, as required by 35 U.S.C. § 102(e). Further reconsideration is thus requested.

**Claim Rejections - 35 U.S.C. § 112:**

Claims 44, 46-50, 52-57, 59-64, 66-72, 74-79, and 81-86 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 44, 46-50, 52-57, 59-64, 66-72, 74-79, and 81-86 have been amended, as discussed above, to replace the recitations "compiling" and "re-compiling" with, e.g. creating, preparing, and re-creating.

Claims 46, 48, 49, 54, 55, 60, 62, 63, 75, 77, 78, 84, and 85 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 46, 48, 49, 54, 55, 60, 62, 63, 75, 77, 78, 84, and 85 were amended to make them more definite. Withdrawal of the rejection is earnestly solicited.

**Claim Rejections - 35 U.S.C. § 102:**

Claims 44, 46-50, 52-57, 59-64, 66-72, 74-79, and 81-86 were rejected under 35 U.S.C. § 102(e) as anticipated by US Publication 2004/0039784 to Jacobs et al., (hereinafter "Jacobs"). The rejection is traversed to the extent it might apply to the claims as amended.

According to at least one embodiment of the invention, an apparatus for distributing information and a computer program makes it possible for users to obtain information efficiently by, for example, selecting necessary information from among a lot of information stored in a database, and acting for users in arranging of the selected information. As Jacobs, on the other hand, describes at paragraph [0148]:

The PlayList Request, which is sent by the Eudora client to the PlayList server 302 in order to initiate the ad fetch process, is not a simple burst of binary code. The PlayList Request is a block of extensible markup language (XML) code employed to provide the server 302 with sufficient information to build or select the proper New PlayList for the user. The information in the PlayList Request is shown in the following table.

9 PARAMETER DESCRIPTION UserAgent This is a string identifying the application requesting the PlayList, its version number, and the platform on which it is running. PlayList(s) This identifies the PlayList(s) that the client is currently using. This may have multiple values if the client is working off more than one PlayList. Entry A list of the id's of the ads recently shown by this client. The entries are nested inside the PlayList to which they belong. Each entry can have zero or more of the following associated attributes or types (the number following the equal sign (=) indicates an exemplary value attached to the attribute which is used to achieve the description of the entry attributes provided below): Active = "0" The ad is no longer being shown. IsRunout = "1" The ad is a runout ad. This saves the server having to do a lookup on the ad. IsSponsor = "1" The ad is a sponsorship ad, to be shown in place of the QUALCOMM logo. See FIG. 3B. IsButton = "1" The ad is a toolbar button. Deleted = "1" The ad has been hidden

by the user. This is allowed only for toolbar ads. FaceTime This lists the amount of face time the user has used in the last seven calendar days. This allows the server to determine how many ads the client is likely to be able to display. The value for the current day is the greater of today's value (see faceTimeUsedToday) and last week's value for today. FaceTimeLeft This is a total of the amount of face time requested by the ads still left in the client's ad cache. FaceTimeUsedToday This is the amount of face time the client has used toward displaying ads today. It can be used by the server to determine whether a date-critical ad can be shown today. DistributorID This id is used for the bounty system, so that the PlayList Server can identify and credit, commission or otherwise reward the ISP or other organization that distributed this copy of Eudora. Pastry This is a cookie the PlayList Server gave to the Eudora e-mail client in the past. It could contain any state information/ settings the server wishes to save. Profile Profiling information originally entered on the software provider's web page and subsequently/concurrently stored with the e-mail client. Screen.height The height of the display on which the ads are shown, in pixels. Screen.width The width of the display on which the ads are shown, in pixels. Screen.depth The color depth of the display on which the ads are shown, in colors/bits per pixel. PlayListVersion The version # of the PlayList routine employed by this particular client.

Thus, in Jacobs, the PlayList Request is sent by the Eudora client to the PlayList server 302 in order to initiate the ad fetch process. The PlayList Request provides the server 302 with sufficient information to build or select the proper New PlayList for the user. The user never gets to select either the PlayList or the advertisement to be downloaded. This is to be contrasted with the claimed invention, in which users select necessary information from among a lot of information stored in a database.

Claims 44, 50, 57, 64, 72, and 79 in particular, recite substantially:

Transmitting a summary of a plurality of electronic articles stored in the article database to the client computer.

Jacobs, on the other hand, neither teaches, discloses, nor suggests "transmitting a summary of a plurality of electronic articles stored in the article database to the client computer," as recited substantially in claims 44, 50, 57, 64, 72, and 79. As Jacobs, rather, describes at paragraph [0025]:

In one aspect, the present invention provides software, for use on a client device that is configured for communications with at least one remote source of advertisements via a communications network, which instantiates an advertisement download function that downloads advertisements from the at least one remote source, during one or more advertisement download sessions, an advertisement storage function that stores the downloaded advertisements on a storage medium associated with the client device, an advertisement display function that effects display of at least selected ones of the stored advertisements on a display associated with the client device, an audit function that compiles ad-related statistical data relating to the downloaded advertisements, wherein the ad-

related statistical data includes display event-related data regarding advertisements that were displayed during a prescribed audit interval, and an audit data transmit function that transmits the ad-related statistical data to a prescribed server system. Advantageously, the audit data transmit function generates a send audit data display window that requests the user's permission to transmit the ad-related statistical data to the prescribed server system, and the audit data transmit function transmits the ad-related statistical data only in response to a user's grant of permission to do so.

Thus, in Jacobs, the *software* instantiates an advertisement download function that downloads advertisements from the at least one remote source. This is to be contrasted with claims 44, 50, 57, 64, 72, and 79, which recite substantially "transmitting a summary of a plurality of electronic articles stored in the article database to the client computer."

Furthermore, as Jacobs describes at paragraph [0059]:

Referring now to specific drawings, FIG. 1 illustrates an exemplary system configuration 10 which is suitable for carrying out the functions according to representative embodiments of the present invention. Although the representative embodiment will be generally described with respect to an electronic mail (e-mail) system where a number of users can create, send, receive and read e-mail messages, the present invention is not so limited. For example, the present invention is equally applicable to a personal digital assistant (PDA) incorporating specialized software for receiving stock quotations via a wireless network. Thus, the principles of the present invention should not be regarded as limited solely to e-mail systems; the principles of the present invention apply to on-line services where a provider, e.g., a software provider, desires to make its software available to users using a variety of payment options for a core set of software functions.

Thus, in Jacobs, a *provider*, e.g., a software provider, desires to make its software available to users using a variety of payment options for a core set of software functions. This is to be contrasted with claims 44, 50, 57, 64, 72, and 79, which recite substantially "transmitting a summary of a plurality of electronic articles stored in the article database to the client computer."

Claims 44, 50, 57, 64, 72, and 79 recite substantially further:

Receiving a specification from the client computer in response to the summary, the specification specifying which electronic article is selected by a user of the client computer.

Jacobs neither teaches, discloses, nor suggests "receiving a specification from the client computer in response to the summary, the specification specifying which electronic article is selected by a user of the client computer," as recited substantially in claims 44, 50, 57, 64, 72, and 79. In Jacobs, rather, the *software* instantiates an advertisement download function that downloads advertisements from the at least one remote source, as discussed above. This is to be contrasted with claims 44, 50, 57, 64, 72, and 79, which recite substantially "receiving a

specification from the client computer in response to the summary, the specification specifying which electronic article is selected by a user of the client computer."

As Jacobs describes further at paragraphs [0173]:

The "action" value determines what function the user wishes to perform. The software provider then appends various other query parts to the URN, suitably %-escaped, i.e., separated by a percentage (%) or ampersand (&) symbol (for example), according to the chart illustrated in FIG. 19. A brief discussion of each type of web page referenced in FIG. 19 is provided immediately below.

**13 PAYMENT** This web page should take the user's credit card **WEB PAGE** info, name, e-mail address, and whatever other information the software provider wants to compile about its users. It will also ask them for a question and answer for use if they ever lose their payment code. It should return, e.g., display and also e-mail, their official registration name and registration code. **FREEWARE** This web page should take the same info as the **REGISTRATION** Payment web page, minus the credit card **WEB PAGE** information. It should send back (that is, display and also e-mail) their official registration name and registration code. **ADWARE** This web page should take the same info as the **REGISTRATION** Payment web page, minus the credit card **WEB PAGE** information. It should send back (that is, display and also e-mail) their official registration name and registration code. **BOX** This web page exists to accept registrations **REGISTRATION** generated by Box or updater installers. It should **WEB PAGE** simply accept the user's code, validate it, mail it back, and display a "thank you for registering" page or dialog box. **LOST CODE** This web page helps users find their registration **WEB PAGE** codes. When they register/pay, they'll be asked to provide their name, e-mail address, and a question and answer. When they come to the lost code page, they'll be asked for name and address, and if that matches, they'll be asked their question. If all that goes well, their RegCode will be mailed to them. If they can't receive mail, they'll have to call. **UPDATE** This web page should list the updates that are **WEB PAGE** available to the user. Ideally, it would list only those updates the user does not already have, and clearly indicate which updates are free and which updates the user needs to pay for. This web page will be downloaded to the user's system from time to time and displayed "off-line" in Eudora, and so it should be kept small. **ARCHIVED** This web page should list all versions of Eudora, so **VERSIONS** that users can download whatever they happen to **WEB PAGE** need. **PROFILE** The purpose of this web page is to collect **WEB PAGE** demographic information so that ads delivered to the user can more precisely targeted by advertisers. At this page, the user will be asked a series of questions about his/her personal preferences, habits, etc., e.g., buying habits, sleeping habits, preferences in clothing, etc. No information identifying the user is to be collected on this page! The information will be reduced to a cookie, mailed to Eudora and stored as part of the user's settings in the Eudora directory (folder). The procedure for accepting a profile is the same as the procedure for accepting a registration code, detailed below. **SUPPORT** The software provider will need several web pages **WEB PAGES** for resolving user problems. For these pages, the software provider will use the "topic" part of the query to direct users to situation-specific help as needed.

Thus, in Jacobs, a web page collects WEB PAGE demographic information so that ads *delivered* to the user can more precisely targeted by advertisers. This is to be contrasted with claims 44, 50, 57, 64, 72, and 79, which recite substantially "receiving a specification from the client computer in response to the summary, the specification specifying which electronic article is selected by a user of the client computer.

Claims 44, 50, 57, 64, 72, and 79 recite substantially further:

Extracting an advertisement from an advertisement database based on the electronic articles extracted.

Jacobs neither teaches, discloses, nor suggests "extracting an advertisement from an advertisement database based on the electronic articles extracted," as recited substantially in claims 44, 50, 57, 64, 72, and 79. In Jacobs, rather, the *software* instantiates an advertisement download function that downloads advertisements from the at least one remote source, as discussed above. This is to be contrasted with claims 44, 50, 57, 64, 72, and 79, which recite substantially "extracting an advertisement from an advertisement database based on the electronic articles extracted."

Finally, claims 44, 50, 57, 64, 72, and 79 recite substantially:

Uploading the homepage created to a predetermined website.

Jacobs neither teaches, discloses, nor suggests "uploading the homepage created to a predetermined website," as recited substantially in claims 44, 50, 57, 64, 72, and 79. As Jacobs, rather, describes at paragraph [0062]:

Referring again to FIG. 1, each of the client computers 100a, 100b, . . . , 100n can selectively communicate with any of the servers, e.g., servers 301-304, via the network 200. In the computer system 10 depicted in FIG. 1, each of the servers performs a specialized function. In an exemplary case, server 301 performs a registration function, i.e., accepts registration information from each client computer (as discussed in greater detail below), server 302 provides PlayLists to the client computers 100a, 100b, . . . , 100n, server 303 provides the advertisements designated in the PlayLists, and server 304 acts as a conventional e-mail system server system, i.e., provides both the incoming e-mail server and the outgoing e-mail server. It should be mentioned that only servers 301 and 302 need actually be under the direct control of the software provider, e.g., QUALCOMM INCORPORATED in the preferred embodiment, although server 303 advantageously may be under the control of the software provider as well. It should also be mentioned that the reference to software should not be construed as limited to disk based software; the term "software" should be broadly interpreted as instructions carried out by a processor, whether these instructions are read from a dynamic memory or stored as firmware in an read only memory (ROM) or other variants of such a device.

Thus, in Jacobs, server 301 performs a registration function, i.e., accepts registration information from each client computer (as discussed in greater detail below), server 302 provides PlayLists to the client computers 100a, 100b, . . . , 100n, server 303 provides the advertisements designated in the PlayLists, and server 304 acts as a conventional e-mail system server system, i.e., provides both the incoming e-mail server and the outgoing e-mail server. This is to be contrasted with claims 44, 50, 57, 64, 72, and 79, which recite substantially "uploading the homepage created to a predetermined website." Claims 44, 50, 57, 64, 72, and 79 are thus submitted to be allowable. Withdrawal of the rejection of claims 44, 50, 57, 64, 72, and 79 is earnestly solicited.

Claims 46-49, 52-55, 59-63, 66-70, 74-78 and 81-85 depend from claims 44, 50, 57, 64, 72, and 79, respectively, and add further distinguishing elements. Claims 46-49, 52-55, 59-63, 66-70, 74-78 and 81-85 are thus also submitted to be allowable. Withdrawal of the rejection of claims 46-49, 52-55, 59-63, 66-70, 74-78 and 81-85 is earnestly solicited.

Claims 56, 71, and 86:

Claims 56, 71, and 86 recite substantially:

Preparing an electronic mail based on the electronic articles extracted.

Jacobs neither teaches, discloses, nor suggests, "Preparing an electronic mail based on the electronic articles extracted," as recited substantially in claims 56, 71, and 86. In Jacobs, rather, the *software* instantiates an advertisement download function that downloads advertisements from the at least one remote source, and a web page collects WEB PAGE demographic information so that ads delivered to the user can more precisely targeted by advertisers, as discussed above. This is to be contrasted with claims 56, 71, and 86, which recite substantially "preparing an electronic mail based on the electronic articles extracted."

Claims 56, 71, and 86 recite substantially further:

Transmitting the electronic mail prepared to the client computer.

Jacobs neither teaches, discloses, nor suggests, "transmitting the electronic mail prepared to the client computer," as recited substantially in claims 56, 71, and 86. Claims 56, 71, and 86 are thus submitted to be allowable. Withdrawal of the rejection of claims 56, 71, and 86 is earnestly solicited.

**New claims 87-92:**

Claims 87-92 depend from either claim 44, claim 57, or claim 72 and add further distinguishing elements. The content of the playlist of Jacobs differs not between users, while, in the claimed invention, the content of the playlist differs between users depending on which the user has specified detailed level. Furthermore, the advertisement selected from the playlist of Jacobs is displayed only on the main screen of Eudora, while, in the claimed invention, the user may specify, in the reply email, whether the detailed information is to be provided as a homepage or an email. The user of the claimed invention thus has greater flexibility in that he or she can check the detailed information when it is received on their mobile phone, or check it later at their personal computer. Claims 87-92 are thus submitted to be allowable as well, for at least those reasons discussed above with respect to the rejections of claim 44, claim 57, or claim 72.

**Conclusion:**

Accordingly, in view of the reasons given above, it is submitted that all of claims 44, 46-50, 52-57, 59-64, 66-72, 74-79, and 81-92 are allowable over the cited references. Allowance of all claims 44, 46-50, 52-57, 59-64, 66-72, 74-79, and 81-92 and of this entire application is therefore respectfully requested.

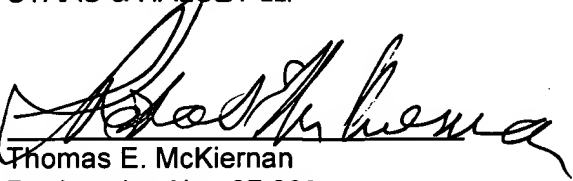
If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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